



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,051	08/06/2001	Michael Numberger	NURNBERGER	9800

20151 7590 03/11/2003

HENRY M FEIEREISEN  
350 FIFTH AVENUE  
SUITE 3220  
NEW YORK, NY 10118

EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
----------	--------------

1746

3

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,051	<b>Applicant(s)</b> NURNBERGER ET AL.	
	<b>Examiner</b> Sharidan Carrillo	<b>Art Unit</b> 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some \* c) ☒ None of:
    - 1. ☒ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear what is meant by "hydroxy acid type". Claim 2 is indefinite because it is unclear what is meant by "salty" reducing sulfur-oxygen compound. Claims 3-5 are indefinite because of its dependency. Claim 6 is indefinite because it is unclear whether the ATMP is spelled incorrectly. Claim 7 is indefinite because it is not further limiting since claim 6 recites a salt. Claim 8 is indefinite because it is unclear what one of ordinary skill in the art would consider as a "wetting agent". Claim 8 is not further limiting since it recites a

Art Unit: 1746

“reducing agent”, the limitations of which have been previously recited in claim 1. Claims 9, 11, and 14-15 are indefinite because of its dependency. Claim 10 is indefinite because it is unclear what is being sprayed. Claim 12 is indefinite because it is unclear whether “plant sections” and “individual parts” refers to only that of the water preparation plant or whether the above phrases refer to each one of the elements recited in claim 12. Claim 13 is indefinite because it is unclear what is meant by the phrase “after treating the well with a solution of an oxidant”. It is unclear whether step d) should recite “d) after step c, treating the well with a solution of an oxidant.

Claims 16-17 provides for the use of the complexing agent, disulfite, and dithionite, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Horwitz et al. (5587142).

Horwitz et al. teach a method of dissolving metal oxides using a mixture of Polyphosphonic acid and a reductant. In reference to claim 1, refer to col. 1, lines 35-40, col. 3, lines 50-65, col. 3, lines 40-45. In reference to claims 2-3, refer to col. 3,

Art Unit: 1746

lines 50-60. In reference to claims 4 and 8, refer to col. 3, lines 5-9. In reference to claim 5, refer to col. 8, lines 45-55. In reference to claims 6-7, refer to col. 3, lines 50-55, col. 3, lines 40-45. In reference to claim 9, refer to col. 1, lines 25-27. In reference to claims 10-11, refer to col. 4, lines 12-20, lines 40-45, col. 8, lines 55-60. In reference to claims 12-13, refer to col. 4, lines 50-60. In reference to claims 14-15, refer to col. 4, lines 45-47. In reference to claims 16-17, refer to col. 3, lines 40-45, col. 1, lines 25-27.

7. Claims 1-3, 5-9, 11-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Waller et al. (4810405).

Waller teaches a method of removing iron oxide deposits from substrates using a phosphonate and a reducing agent, as described in the abstract. In reference to claims 1 and 16, refer to col. 1, lines 20-25. In reference to claims 2-3, refer to col. 1, lines 10-25. In reference to claims 5-6, and 8, refer to Table 1. In reference to claim 7, refer to col. 3, lines 50-53. In reference to claim 9, refer to the abstract. In reference to claims 11-12, refer to Examples 1-2.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flaxman teaches a composition comprising a sequestering agent and a reducing agent for cleaning cooling systems. Morgan teaches a sequestering agent and a reducing agent to treat a well. Alfano teaches citrate and the addition of an oxidizing agent. Dillen teaches using a carboxylic acid and dithionite. Freyhold teaches the use of phosphonic acids for cleaning water systems. Weeter teaches using phosphonates to treat wells. Holder teaches citrate in combination with dithionite. Busch et al. teaches phosphonates for treating boilers. Purohit et al. teach using HEPDA.

Art Unit: 1746

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 703-308-1876.

The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-7719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sharidan Carrillo  
Primary Examiner  
Art Unit 1746

bsc  
March 5, 2003



SHARIDAN CARRILLO  
PRIMARY EXAMINER